

Remarks:

Reconsideration of the application is requested.

Claims 1-11 and 14 remain in the application.

In the third paragraph on page 2 of the above-mentioned Office action, claims 1, 5, 6, 8, and 14 have been rejected as being anticipated by Schmid et al. (US Pat. No. 6,101,944) under 35 U.S.C. § 102(a).

It is noted that the patent date, **August 15, 200⁰₂** of the reference Schmid et al. is later than the priority date **October 15, 1999** of the instant application. Therefore, the reference Schmid et al. is not qualified as a prior art reference under 35 U.S.C. § 102(a). Rather, it is a reference under 35 U.S.C. § 102(e).

A claim for priority was filed on October 16, 2002 together with a certified copy of the priority document. In order to perfect the right of priority, a certified English translation of the priority document is enclosed herewith. The Examiner is therefore requested to change the 102(a) rejection over Schmid et al. to a 102(e) rejection.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 14 call for, inter alia:

a second printing machine having a sheet delivery and at least one zoneless metering device for uniformly metering at least one of ink and varnish, respectively, over a printing width. (Emphasis added.)

The Schmid et al. reference is owned by the corporate assignee of the instant application and Applicants are therefore very familiar with this reference.

The corresponding German Application No. DE 197 43 770 A1 of the reference Schmid et al. has already been mentioned on page 2, line 7 of the specification of the instant application.

In Schmid et al., the reference sign "60" refers to an inking unit (see column 10, line 22). It is not a metering device, let alone a zoneless metering device. A person skilled in the art might assume that the inking unit 60 contains a metering device. However, a person skilled in the art would not assume that the metering device is specifically a zoneless metering

device. From the technical circumstances of the printing machine system described in Schmid et al., one skilled in the art would only assume that the inking unit 60 contains a metering device with divided color zones rather than a zoneless metering device.

Clearly, Schmid et al. do not show "a second printing machine having a sheet delivery and at least one zoneless metering device for uniformly metering at least one of ink and varnish, respectively, over a printing width", as recited in claims 1 and 14 of the instant application.

Claims 1 and 14 are, therefore, believed to be patentable over Schmid et al. and since claims 5, 6, and 8 are ultimately dependent on claim 1, they are believed to be patentable as well.

In the second paragraph on page 3 of the above-mentioned Office action, claims 2 and 3 have been rejected as being unpatentable over Schmid et al. in view of Kolbe et al. (US Pat. No. 6,016,748) under 35 U.S.C. § 103(a). In the third paragraph on page 3 of the above-mentioned Office action, claim 4 has been rejected as being unpatentable over Schmid et al. in view of Hofmann et al. (US Pat. No. 5,503,674) under 35 U.S.C. § 103(a). In the paragraph bridging pages 3 and 4 of the above-mentioned Office action, claim 7 has been rejected

as being unpatentable over Schmid et al. under 35 U.S.C. § 103(a). In the second paragraph on page 4 of the above-mentioned Office action, claims 10 and 11 have been rejected as being unpatentable over Schmid et al. in view of Rodi (US Pat. No. 5,115,741) under 35 U.S.C. § 103(a).

As discussed above, the reference Schmid et al. is only available as a prior art reference under 35 USC 102(e). Under 35 USC 103(c),

"Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made owned by the same person or subject to an obligation of assignment to the same person."

Since the reference Schmid et al. and the invention of the instant application were both owned by Heidelberger Druckmaschinen AG, Germany, at the time the invention of the instant application was made, the reference Schmid et al. shall not preclude the patentability of the invention of the instant application. An assignment is submitted herewith.

For the above reasons, the 103 rejections are believed to be now moot.

In view of the foregoing, reconsideration and allowance of claims 1-11 and 14 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made. Please charge any fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,

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